



IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

T.A.
1-17-03
#14/ENE

In re Patent Application of

GROUP NUMBER 3732

JOHNSON, GARY E.

Serial No.: 09/204,866
Filed: 3 Dec. 1998

For: POWERED CUTTING
SURFACE WITH PROTECTIVE
GUARD FOR EQUINE TEETH
Group: 3732

Examiner: John J. Wilson
Primary Examiner

I hereby certify that this correspondence
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ADDRESSED TO:

Assistant Commissioner of Patents
and Trademarks, Washington,
D.C. 20231

On

John E. Halamka

Dated: 21 December 2002
Torrance, California

Label

RESPONSE

Honorable Assistant Commissioner of Patents and Trademarks
Washington, D. C. 20231
Attn: John J. Wilson

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Dear Examiner Wilson:

Responsive to the Notice of failure to place application in condition
for allowance dated 10/15/02, it is requested that the following remarks
be added to the file.

The examiner stated that "The claims were not amended and their
status remains in the same as for the Final Rejection."

Applicant's attorney has reviewed the file and cannot ascertain any
outstanding requirement in the office actions requiring any further
amendment of the claims.

However, Applicant's attorney did locate a statement in the Office
Action dated 6/12/02, Paper 11, Page 4, as follows:

Applicant's remarks as to the manner in which the shaft is
supported, are not commensurate with the claim language,
therefore, the manner in which the Hicks shaft may behave in use
is given no patentable weight.

Applicant's attorney interpreted this as argument by the examiner and not as a requirement to amend the claim.

Upon examination of the claims as to the issue of the "shaft support not commensurate with the claim language" applicant's attorney found:

Allowed claim 2 contains the following:

a shaft support means through which said shaft may be removably inserted, said shaft support means further comprises a bearing mounted at a preselected position within said shaft support means and a bearing seal mounted at a position between said bearing and said cutting surface through which said shaft may be inserted and supported for rotary motion without binding;

Allowed Claim 12 contains the following:

a shaft support means through which said shaft may be removably inserted;

Allowed Claim 16 contains the following:

a bearing support sleeve;
at least one bearing mounted within said support sleeve at a preselected position whereby said bearing accepts the insertion of said shaft through said bearing thereby exposing the end of said shaft remote from said tooth removal surface, said bearing support sleeve mounted with said internal shaft channel whereby said exposed end of said shaft is attachable to said electric motor, said bearing providing support for said shaft under the condition of said tooth material removal surface tool being guided into contact with a preselected tooth and pressed against the tooth until a preselected

portion of the tooth is removed while said tooth material removal surface is under powered motion;

The shaft support language in claim 12 is defined in the specification starting on page 11 and generally referring to item 301 which constitutes a bearing sleeve 304 within which is mounted an upper bearing 305 and bearing seal 306 and a lower seal 307.

Unlike elements 19 and 20 of Hicks, US Patent No. 2,429,356, which in the examiner's opinion provides "SHAFT SUPPORT" to the Hicks shaft element 15, applicant's shaft support actually provides mechanical support of the shaft by element 304, a bearing. The elements 19 and 20 of Hicks merely make a pathway, as each element has a groove but the additional elements taught by Hicks of 23 and 24 interlock to hold elements 19 and 20 apart so that the shaft 15 may be inserted through the opposing grooves of 19 and 20 which then simply "do not bind" the shaft but do not provide any support or protection against binding should pressure be placed on the shaft 15 sufficient to come into contact with either element 19 or 20. Applicant's attorney respectfully contends that it was this misinterpretation of Hicks by the examiner that led to the examiner's rejection of claims 1,4-6, 9-11, 14 and 15 unless the examiner agrees and would now allow the claims.

Thus, making the language in claim 12 consistent with the language in claim 2, or claim 16, would not add any new matter to claim 12.

Applicant's attorney respectfully requests that Claim 12 be amended to add the language of claim 2 as follows:

In Claim 12, line 8, after "inserted", insert --,said shaft support means further comprises a bearing mounted at a preselected position within said shaft support means and a bearing seal mounted at a position between said bearing and said cutting surface through which said shaft may be inserted and supported for rotary motion without binding--

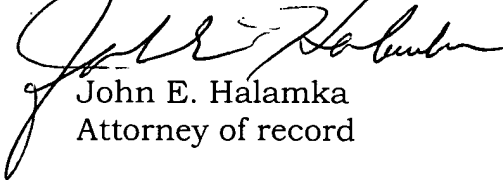
Substitute pages for pages 27 through 31 are included in this response to reflect the requested insertion.

Applicant's attorney believes this is the issue and thus the alignment of claim 12 with claims 2 and 16 should place this application in condition for allowance.

Applicant's attorney does not believe any fees are due upon the filing of this response, however if the examiner does find that any fees are due, the examiner is authorized to charge the fees to Applicant's attorney's deposit account 08-0207.

Timely notice of acceptance of this paper is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John E. Halamka", is written over the printed name and title.

John E. Halamka
Attorney of record

Attachment: substitute pages for claims 1-29.